B.   REMARKS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 2, 3, 14, 15, 29, 30 and 39-41 have been canceled, Claims 1, 4-8, 13, 16-20 and 28 have been amended and new Claim 42 added. Claims 25-27 have been withdrawn by virtue of the prior election for examination of Claims 1-24 and 28-41. Hence, Claims 1, 4-13, 16-24, 28, 31-38 and 42 are pending in this application. The amendments to the claims and the new claim do not add any new matter to this application. All issues raised in the Office Action mailed November 8, 2004 are fully addressed hereinafter.

REJECTION OF CLAIMS 39-41 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 39-41 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in that they fail to point out what is included or excluded by the claim language. This rejection is moot in view of the cancellation of Claims 39-41. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

REJECTION OF CLAIMS 1-12 AND 39-41 UNDER 35 U.S.C. § 101

Claims 1-12 and 39-41 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is now moot with respect to canceled Claims 39-41. Regarding Claims 1-12, the stated basis for the rejection is that Claims 1-12 recite an invention that is merely an abstract idea that is not within the technological arts.

Claims 1-12, as amended, recite a computer-implemented method for estimating how a user would rate an item that the user has not yet rated. The approach has a wide variety of real world and concrete applications. For example, the approach may be used to recommend movies or games to a customer for rent. Also, the claims, as amended, recite the functionality being

performed in a computer system. It is therefore respectfully submitted that Claims 1-12 recite an invention that is not merely an abstract idea and is within the technological arts.

In view of the foregoing, reconsideration and withdrawal of the rejection of Claims 1-12 under 35 U.S.C. § 101 is respectfully requested.

REJECTION OF CLAIMS 1-24 AND 28-41 UNDER 35 U.S.C. § 102(e)

Claims 1-24 and 28-41 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Chislenko*, U.S. Patent No. 6,041,311. This rejection is moot with respect to canceled Claims 2, 3, 14, 15, 29, 30 and 39-41. It is respectfully submitted that Claims 1, 4-13, 16-24, 28 and 31-38, as amended, are patentable over *Chislenko* for at least the reasons provided hereinafter.

CLAIM 1

Claim 1, as amended, recites a computer-implemented method for estimating how a user would rate an item that the user has not yet rated that recites:

> "in a computer system identifying one or more items that have been rated favorably by the user and that have ratings that satisfy a minimum rating threshold;
> in the computer system identifying one or more other users that have rated the one or more items and given ratings to the one or more items that are substantially similar to ratings given by the user to the one or more items; and
> in the computer system estimating how the user would rate the item that the user has not yet rated based upon how the one or more other users rated the item."

It is respectfully submitted that Claim 1 is patentable over *Chislenko* because Claim 1 recites one or more limitations that are not taught or suggested by *Chislenko*. For example, it is respectfully submitted that the Claim 1 limitation "identifying one or more items that have been rated favorably by the user and that have ratings that satisfy a minimum rating threshold" is not taught or suggested by *Chislenko*. In the collaborative filtering method of *Chislenko*, there is no teaching or suggestion that the items rated by the user are identified based upon the user having

rated them favorably and the items having ratings that satisfy a minimum rating threshold, as recited in Claim 1. *Chislenko* describes how user profiles are accessed to calculate similarity factors between any two users with respect to a set of items. There is no mention of selecting the set of items to be used in the similarity determination based upon whether the set of items have been rated favorably by a user and have ratings that satisfy a minimum rating threshold.

The Office Action relied upon the text at *Chislenko* at Col. 8, lines 19-34 for teaching the limitation "identifying one or more items that have been rated favorably by the user." This portion of *Chislenko* describes how considerations other than the similarity factor between users may be used to place users in a rating user's neighbor set. For example, it may be known for reasons other than the similarity factor that it is desirable to include one user in the neighbor set of another user based upon historical experience. Thus, while the Claim 1 limitation "identifying one or more items that have been rated favorably by the user" is related to identifying items that are to be used in the estimation determination, this portion of *Chislenko* relates to how to select the other users that will be compared to the rating user. It is therefore respectfully submitted that the Claim 1 limitation of "identifying one or more items that have been rated favorably by the user" is not taught or suggested by *Chislenko*.

The Office Action relied upon the text at Col. 9, line 62 through Col. 10, line 6 for teaching the limitation "identifying one or more items that … that have ratings that satisfy a minimum rating threshold." This portion of *Chislenko* describes how the number of items ultimately recommended to a user may be selected based upon items having the highest predicted ratings. This portion of *Chislenko* relates to the end of the collaborative filtering process and how to reduce the number of recommendations provided to users. It is not related to selecting the items to be used for the correlation process based upon the selected items having ratings that

satisfy a minimum rating threshold. It is therefore respectfully submitted that the Claim 1 limitation of "identifying one or more items that ... that have ratings that satisfy a minimum rating threshold" is also not taught or suggested by *Chislenko*.

In view of the foregoing, it is respectfully submitted that Claim 1 includes one or more limitations that are not taught or suggested by *Chislenko*.

CLAIMS 4-12

Claims 4-12 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 4-12 are patentable over *Chislenko* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 4-12 recite additional limitations that independently render them patentable over *Chislenko*.

CLAIMS 13 AND 16-24

Claims 13 and 16-24 recite limitations similar to Claims 1 and 4-12, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 13 and 16-24 are patentable over *Chislenko* for at least the reasons set forth herein with respect to Claims 1 and 4-12.

CLAIMS 28 AND 31-38

Claims 28 and 31-38 recite limitations similar to Claims 1 and 4-11, except in the context of a apparatuses. It is therefore respectfully submitted that Claims 28 and 31-38 are patentable over *Chislenko* for at least the reasons set forth herein with respect to Claims 1 and 4-11.

In view of the foregoing, it is respectfully submitted that Claims 1, 4-13, 16-24, 28 and 31-38 are patentable over *Chislenko*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1, 4-13, 16-24, 28 and 31-38 under 35 U.S.C. § 102(e) as being anticipated by *Chislenko* is respectfully requested.

<div align="center">NEW CLAIM 42</div>

New Claim 42 recites limitations similar to method Claim 12, except in the context of an apparatus. It is therefore respectfully submitted that new Claim 42 is patentable over *Chislenko* for at least the reasons set forth herein with respect to Claim 12.

<div align="center">CONCLUSION</div>

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

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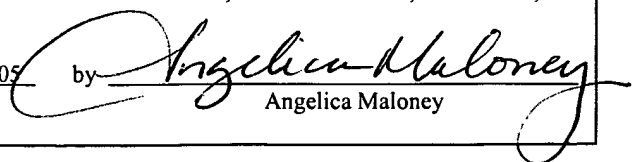Reg. No. 37,777
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